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EXAMINER

GARG, YOGESH C

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/876,577

Applicant(s)

ANDERSON, GLEN J.

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's amendment received on 11/16/2004 is acknowledged and entered. The applicant has amended claims 1, 8, 9, 13, 16, and 34 and added new claims 25-30. Currently claims 1-30 are pending for examination.

### *Response to Arguments*

2.1. Applicant's arguments filed on 11/16/2004 concerning rejection of claims 1-2 and 4-8 under 35 USC 101 have been fully considered but they are not persuasive. The amendment has been made in the preamble only and not in the body of the claims. The claim preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. In order to limit the claim, the preamble must be "essential to point out the invention defined by the claim." Kropa v. Robie, 88 USPQ 478, 481 (CCPA 1951) (discussed below). In claims directed to articles and apparatus, any phraseology in the preamble that limits the structure of that article or apparatus must be given weight. In re Stencel, 4 USPQ2d 1071 (Fed. Cir. 1987). **On the other hand, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone.** In re Hiraq, 535 F.2d 67, 190 USPQ 15 (CCPA 1976); Kropa v. Robie, 88 USPQ 478, 481 (CCPA 1951). In the amended claim 1, the preamble is only directed to the purpose of the process and the intended use of the structure, and the steps (a), (b) and (c) could stand alone and did not depend on the preamble for completeness. Therefore, rejection of claims 1-2 and 4-8 under USC 101 is maintained.

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2.2. Applicant's arguments, see pages 1-2 of Remarks, filed on 11/16/2004, with respect to rejection of claims 8, 16 and 24 under 35 USC 112, second paragraph have been fully considered and are persuasive in view of the amendments made to these claims. The rejection of claims 8, 16 and 24 under 35 USC 112, second paragraph has been withdrawn.

2.3. Applicant's arguments, see pages 2-3 in Remarks, filed on 11/16/2004, with respect to the rejection(s) of claim(s) 1-4, 9-13 and 17-21 under USC 102 have been fully considered but they are not persuasive. The applicant argues that Henson does not disclose the limitations such as, "Take good quality pictures to e-mail to friends. Print color images at 1 page per minute" and "Record 15 second video clips. Listen to music on your camera. Print photo quality color images at 10 pages per minute". In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "Take good quality pictures to e-mail to friends. Print color images at 1 page per minute" and "Record 15 second video clips. Listen to music on your camera. Print photo quality color images at 10 pages per minute") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, the rejection of independent claims 1, 9 and 27 and their dependencies is maintained.

2.4. The applicant further argues that the reference Tuzhilin does not disclose the limitations "a list of browsed products or a current component configuration.". In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are part of alternative expression, that is at least one of ..... Tuzhilin reads upon at least two of the attributes that is, "a list of prior purchases and user provided personal characteristic information" in the form of "static profile", which satisfies the

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condition of at least one of, and, therefore, should be sufficient to read on the limitation recited in claims 7, 15 and 23. Therefore, the rejection is still maintained.

2.5. The applicant has traversed the rejection of claims 8, 16 and 24 under 35 USC 103 (a) as being obvious over Henson in view of Official Notice. Since the limitation for which the examiner took Official Notice is deleted, the applicant's traversal is now moot.

2.6. The applicant's arguments against newly added claims 25-30 have been considered but are moot for new grounds of rejection necessitated due to new limitations.

This is a Final rejection.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-2 and 4-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

#### **3.1. Claimed Invention(s) does not fall within the Technological Art.**

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The

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phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analyses go towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, ***State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).**



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In the present application, none of the steps in claims 1-2 and 4-8 recites use of technological arts in processing data. The amendment has been made in the preamble only and not in the body of the claims. The claim preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. In order to limit the claim, the preamble must be "essential to point out the invention defined by the claim." Kropa v. Robie, 88 USPQ 478, 481 (CCPA 1951) (discussed below). In claims directed to articles and apparatus, any phraseology in the preamble that limits the structure of that article or apparatus must be given weight. In re Stencel, 4 USPQ2d 1071 (Fed. Cir. 1987). **On the other hand, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone.** In re Hirao, 535 F.2d 67, 190 USPQ 15 (CCPA 1976); Kropa v. Robie, 88 USPQ 478, 481 (CCPA 1951). In the amended claim 1, the preamble is only directed to the purpose of the process and the intended use of the structure, and the steps (a), (b) and (c) could stand alone and did not depend on the preamble for completeness. The steps recited in the claims 1-2 and 4-8 for providing a list of configuration choices, updated configuration choices, providing description of functions, receiving a selection of system configuration, presenting configuration choices in form of graphical icons, and developing personal history file for the user could be performed manually by people. Therefore, the claims are directed towards non-statutory subject matter. To overcome this rejection, the examiner recommends amending the claims to better clarify which of the steps are being performed within the technological arts, such as incorporating/integrating a computer/software/hardware computer network or electronic network functionally with manipulative steps recited in the claims.

***Claim Rejections - 35 USC § 112, first paragraph***

4. The following is a quotation of the first paragraph of **35 U.S.C. 112**:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 25, 27 and 29 are rejected under **35 U.S.C. 112**, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Newly added claims 25, 27 and 29 recite the limitation, "said description is a function of the particular system configuration rather than of a function of an individual element of the particular system ". There does not appear to be a written description of this claim limitation. The originally filed specification, see page 3, line 29-page 4, line 2 discloses that the said function is capable of being implemented by a system configuration 240 or may be by a component. The applicant's originally filed disclosure does not describe clearly and explicitly that the said description is a function of the particular system configuration rather than of a function of an individual element of the particular system. An skilled artisan would not have recognized the description of this limitation in the disclosure of the application as filed because this limitation excludes the fact that the said description may also include a function related to any of the component of the system configuration. In conformity with the disclosure as filed, these claims would be further treated with said description is of a function of the particular system configuration or a function of a component of the system configuration.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.1. Claims 1-4, 8-12, 16-20 and 24-25, 27 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Henson.

Regarding claim 1, Henson teaches a method for configuring a build-to-order system (See at least abstract), comprising:

(a) providing a list of configuration choices, said list comprising available system elements with which said build-to-order system are configured;

(b) receiving a system configuration selection based on a combination of system elements selected from said list of configuration choices; and

(c) providing a description of a function capable of being implemented with said system configuration selection.

(For all the above three limitations see at least col.6, lines 18-43, " *Turning now to FIG. 3 (3A, 3B, and 3C), from a system configuration options screen 70, a customer of the online store 10 can build a customer configured machine by selecting from options listed on the configuration screen 70. The pricing option module 28 includes an update price function. The update price function causes the price displayed on the configuration screen to reflect any changes made to the system options. Selection of the update price function can be accomplished by clicking on an "UPDATE PRICE" icon 72 on the configuration screen. Upon obtaining a desired configuration, a customer could then select the "ADD*

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*TO CART" icon 74 to add the configured system to the shopping cart 20 and continue shopping, as desired. ....* ". Note: In Figs. 3 A, 3 B and 3C Henson discloses providing a list of configuration choices in the form of displaying various choices for selecting memory, hard drive, monitor, etc., thereby prompting an user to make selections to configure and order a build-to-order computerized system. While presenting the choices, Henson also provides description of functions, see Fig. 3A: such as, a larger hard drive provides more storage space for the operating system..., monitors can deliver enhanced resolution and refresh rates, crisp, vibrant imaging and amazing color depth, etc.. Also, see FIG.5 and col.9, lines 9-25)

Regarding claim 2, Henson teaches that the method as claimed in claim 1, further comprising the steps of: (a) receiving an updated system configuration selection; and (b) providing an updated description of a function capable of being implemented with said updated system configuration selection (see at least FIG.3C which discloses that by clicking the icon "UPDATE PRICE" on the bottom of Fig.3B the user receives an updated configuration selection with the updated price and functions also because any changes in the options would inherently show descriptions corresponding to the changed options).

Regarding claims 3 and 4, Henson teaches that the method as claimed in claim 1, wherein said list of configuration choices is presented in a graphical user interface and wherein at least one of said available system elements in said list of configuration choices being represented by an icon (see FIG.5 and col.9, lines 9-25 which shows that the options are represented by icons and menus on the screen and that is indicative of the use of a graphical user interface. Figs. 3A, 3B and 3C show the use of menus and dialog boxes and they are indicative of the use of a graphical user interface).

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Regarding claim 8, Henson teaches a method for configuring a build to order system as analyzed and discussed above. Henson further discloses said description of function capable of being implemented with said system configuration selection includes at least one of advantages of said selection and suggestions for other selections (see FIG.3A, " Monitor...Upgrading to a larger monitor....exceptional monitors can deliver enhanced resolution and refreshing rates..... Sound Card .....Storage products....Back up valuable files....FIG.3B, " Scanners...." Wherein Henson describes the advantage of selecting a scanner), suggestions for other selections (see FIG.3B besides suggesting the selection of scanner it also suggests other selections such as, Software and accessories, power protection, etc.. Note: Dell provides a description of a function capable of being implemented, such as for scanners, monitors, storage products and all of these products are components of the computer system being configured).

Regarding claims 9-12, 16-20, and 24 their limitations are closely parallel to the limitations of claims 1-4 and 8 and are therefore analyzed and rejected on the same basis.

Regarding new claim 25 [it is being further treated in light of 35 USC 112, first paragraph rejection above], Henson discloses that said system configuration selection of claim 1 comprises selection of a particular configuration of system elements making up a particular system configuration so that said description is a function of the particular system configuration or of a component of the system configuration (see FIG.3A, " Monitor...Upgrading to a larger monitor....exceptional monitors can deliver enhanced resolution and refreshing rates..... Sound Card .....Storage products....Back up valuable files....FIG.3B, " Scanners...." Wherein Henson describes the advantage of selecting a scanner), suggestions for other selections (see FIG.3B besides suggesting the selection of scanner it also suggests other selections such as, Software

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and accessories, power protection, etc.. Note: Dell provides a description of a function capable of being implemented, such as for scanners, monitors, storage products and all of these products are components of the computer system being configured).

Regarding claims 27 and 29 their limitations are closely parallel to the limitations of claim 25 and are therefore analyzed and rejected on the same basis.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6.1. Claims 5-7, 13-15 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson in view of Tuzhilin (US Patent 6,236,978).

Regarding claims 5 & 6, Henson teaches a method for configuring a build to order system as analyzed and discussed in claim 1 above. Henson teaches identifying customers if they belong to a particular customer set (see col.13, lines 30-52) and then presenting the options accordingly. Henson does not disclose the step of developing a personal user history file for each user and including customized information pertaining to each user. However, in the same endeavor of e-commerce, Tuzhilin discloses the step of developing a personal user history file for each user (see at least FIGS 1, 2, col.2, lines 24-40, " *The system and method according to the present invention generates dynamic profiles and, thereafter, transforms the dynamic profiles for various users into aggregate rules. ....* "). In View of Tuzhilin, it would have been obvious to a skilled artisan in the art to have modified Henson to incorporate the feature of

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developing a personal user history file for each user and use this personal history file to provide customized information pertaining to each user because to provide better recommendations to the users as to which product and services each individual user should utilize, as explicitly disclosed in Tuzhilin ( see at least col.2, lines 41-59).

Regarding claim 7, Henson in view of Tuzhilin, as applied to claim 5, teaches a method for configuring a build to order system based upon a personal history file of the user as analyzed above. Henson in view of Tuzhilin, as applied to claim 5, does not disclose that said personal history file includes at least one of a list of prior purchases, a list of browsed products, a current component configuration, and user-provided personal characteristic information. However, in the same endeavor of e-commerce, Tuzhilin discloses that said personal history file includes at least one of a list of prior purchases, a list of browsed products, a current component configuration, and user-provided personal characteristic information (see at least FIGS 1, 2, col.2, lines 24-59, "*The system and method according to the present invention generates dynamic profiles and, thereafter, transforms the dynamic profiles for various users into aggregate rules. ....*" , and col.1, lines 27-col.2, line 10, "*There are two basic types of user profiles that can be generated-- a "static" profile and a "dynamic" profile. The static profile contains all of the factual information of the user including, for example, demographic data (e.g., age, sex, address), psychographic data (e.g., personality traits and habits), purchasing preferences (e.g., what does the user purchase in an average week), etc. Static profiles are generated using conventional methods that are known to those of ordinary skill in the art. ....Dynamic profiling information includes specific rules describing the user's behavior. .... In order to obtain an extensive understanding of the user, it is desirable to build both static and dynamic profiles for that user. ....*" ). In View of Tuzhilin, it would have been obvious to a skilled artisan in the art to have modified Henson to incorporate the feature of developing a personal user history file for each user by including at least one of a list of prior purchases, a list

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of browsed products, a current component configuration, and user-provided personal characteristic information because to provide better recommendations to the users as to which product and services each individual user should utilize, as explicitly disclosed in Tuzhilin ( see at least col.2, lines 41-59).

Regarding claims 13-15 and 21-23 their limitations are parallel to the limitations of claims 5-7 and are therefore analyzed and rejected on the same basis.

6.2. Claims 26, 28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson in view of Tuzhilin and further in view of Roberts et al. (US Patent 6,101,486), hereinafter, referred to Roberts.

Regarding claim 26, Henson in view of Tuzhilin teaches a method for configuring a build to order system using a personal history file as analyzed and discussed above in claim 5. Henson in view of Tuzhilin does not explicitly disclose that the personal history file includes obtaining information about each user's current products and components, wherein said description of function capable of being implemented with said system configuration selection includes comparison information regarding said selection and the user's current products and components. However, in the field of same endeavor, Roberts discloses that the personal history file includes obtaining information about each user's current products and components, wherein said description of function capable of being implemented with said system configuration selection includes comparison information regarding said selection and the user's current products and components (see at least abstract and col.6, line 12-col.7, line 55, ".....A comparison between the customer profile and the company database is performed to create a listing of products or services not currently owned or used by the customer (Step 440). Preferably, the customer profile includes a listing of services and products currently possessed by the customer. This first



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*comparison generates a product list that includes products within the company's database that are not currently owned by the customer and of potential interest to the customer..... Likewise, if a customer has already purchased a particular product from the company, the comparison would identify products and services that could operate in conjunction with, or offer improvements over, the customer's current inventory of products and services. ...." ).* In View of Roberts, it would have been obvious to a skilled artisan in the art to have modified Henson in view of Tuzhilin to incorporate the feature that the personal history file includes obtaining information about each user's current products and components, wherein said description of function capable of being implemented with said system configuration selection includes comparison information regarding said selection and the user's current products and components because the customized service based upon the gathered user's profile on current products and components would serve the specific needs and interests of the user better, see Roberts col.6, lines 12-16).

Regarding claims 28 and 30 their limitations are parallel to the limitations of claim 26 and are therefore analyzed and rejected on the same basis.

### **Conclusion**

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US Patent 6,578,013 to Davis et al.. (see at least abstract and col.1, lines 62-67) teaches a method and a system to *".....for communicating between supplier and customer devices wherein less reliance of human management is achieved. To this end, a system includes a computing device for storing criteria under which a customer is authorized to purchase a physical item. The computing device receives a request from the customer. In response to the request satisfying the stored criteria, the computing device outputs a signal for purchasing the physical item. ....".*).

(ii) US Patent 6,230,199 to Revashetti et al. (see at least abstract and col.5, lines 5-12) discloses "*.... a method and system for marketing products based upon the detection and analysis of software and hardware components or peripherals present on a client computer..*").

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

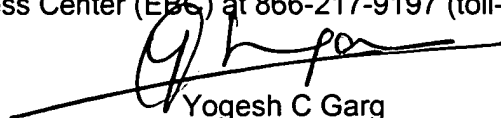
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Yogesh C Garg', is written over a horizontal line.

Yogesh C Garg  
Primary Examiner  
Art Unit 3625

YCG  
February 20, 2005